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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,288	03/29/2000	Masao Okada	862.C1871	7078

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EXAMINER

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,288

Applicant(s)

OKADA ET AL. *CH*

Examiner

John M Hotaling II

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 19-28 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19-28 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17,19-28 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attenberg US Patent 5,913,019 in view of Drake et al US Patent 5,487,010. Attenberg discloses all of the instant application but does not specifically disclose the use of a virtual keyboard. Specifically Attenberg discloses in Column 2 that the machine uses a touch screen to operate all functions from a displayed user friendly menu, a plurality of backgrounds, users may choose from among a menu of different computer generated, background or foreground images, multiple images on the same sheet that may be peeled off separately, that the user may modify the image, a composite image. Columns 3 and 4 disclose the use of a keypad, keyboard and a touchscreen. Columns 5 and 6 disclose that the stickers may have a variety of intended uses and that electronic processing techniques for generating first electronic image information from a projected image and for electronically incorporating a background image into the first electronic image information are well known in the art. Column 6:16-21 disclose that techniques for electronically formatting and generating the electronic multiple information from the electronic single image information such that a printer will print out multiple images of the same image on a single sheet, are well known to those skilled in the art. Column 6:60-65 disclose that it is possible to eliminate the keypad and

Art Unit: 3713

the functions performed by the keypad be installed in a touch screen. Column 7 discloses modifying the image and column 8 discloses a currency acceptor. With respect to claims Attenberg lacks in disclosing the use of a virtual keyboard used with a touch screen. However, Attenberg discloses the use of a keyboard and that it is well known to place the functions of a keypad, which is a simplified version of a keyboard, onto a touch screen. In an analogous invention to Drake discloses a bumper sticker making apparatus which discloses that a touch screen and a keyboard are analogous input devices in column 1:45-51. Drake discloses allowing the user to present the user's own customized slogan. With respect to the specific types of stickers Attenberg and Drake have the apparatus to print and layout any type of background, foreground and text. Attenberg and Drake are analogous inventions in that they are both related to sticker making kiosks. One of ordinary skill in the art would implement a virtual keyboard into the present machines given the motivation above that the functions of a keypad may be transferred to a touch screen and that a touch screen and a keyboard are analogous input devices for use in a sticker printing machine as disclosed by Attenberg. It would be obvious to one of ordinary skill in the art to implement a virtual keyboard in either of the references given the motivation that both sticker printing kiosks use touch screens.

Remarks

2. The claim objections and the 112 and 101 rejections have been overcome based on further consideration and the remarks of the applicant.

Response to Arguments

3. Applicant's arguments filed 10/22/03 have been fully considered but they are not persuasive.

With respect to the applicant's arguments that Attenberg and Drake do not disclose all of the elements of claim 17 please see the rejection above and note that the rejection is based on a combination of the references.

With respect to the applicant's arguments that Drake is not seen to provide for inputting a plurality of character strings to be printed on a sticker see figure 4d.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation has been made clear in the rejection above. In making a article to be printed, on a computer or in a kiosk, formatting of such an object, color, boarder, orientation rotation etc. are well known. Examples of such can be seen in the prior art of record.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7777.

JOHN M. HOTALING, II
PRIMARY EXAMINER

January 14, 2004

